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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,819	04/09/2004	Kuniharu Takayama	1341.1200	8894

21171 7590 11/02/2007

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EXAMINER	
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ART UNIT	PAPER NUMBER
2144	

MAIL DATE	DELIVERY MODE
11/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/820,819	TAKAYAMA ET AL.	
	Examiner	Art Unit	
	Saeed S. Mirzadegan	2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *09 April 2004* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *04/09/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 04/09/2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

3. Figures 21 & 22 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-8 are rejected under 35 U.S.C. 101 because the invention as claimed are directed to nothing but software and do not produce a tangible result as set forth in MPEP 2106.

6. In order for software claims to be statutory, they must be claimed in combination with an appropriate medium and/or hardware to establish statutory category of invention and enable any functionality to be realized as set forth in MPEP 2106.01.

Software, *per se*:

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)
Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "the sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abkermeier (Abkemeier) US PG Pub. No. 2003/0023736 in view of Schiavone et al. (Schiavone) US PG Pub. No. 2002/0120705.

9. Regarding Claim 1, Abkemeier discloses obtaining from an information user device permission for providing information to the information user device (see e.g. Fig. 4, step 51, authorization request); receiving permission information corresponding to the permission (see e.g. Fig. 4, step 55), the permission information being issued by the information user device (see e.g. Fig. 4, step 56, step 58, authorization issued); and transmitting the information and the permission information received to the information

user device (see e.g. page 7, ¶0071, lines 6-9). However, Abkemeier does not explicitly teach a permission level related to usability of the information to a user.

10. In the same field of endeavor, Schiavone teaches priority levels associated with email messages based on various factors (see e.g. page 3, ¶0021).

11. It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Schiavone's teachings as discussed above with the teachings of Abkemeier, for the purpose of lessening or avoiding the impact of virus, spam and denial of service attacks (see Schiavone, ¶0006, page 1, lines 9-11). Abkemeier provides motivation to do so, by providing a system and method for filtering unauthorized messages received by a message recipient while providing an opportunity for senders of unauthorized messages to request authorization (see Abkemeier, page 2, ¶0019, lines 1-4).

12. Regarding Claim 2, Abkemeier and Schiavone disclose the invention substantially as claimed. However Abkemeier does not explicitly teach offering a privilege to the user in accordance with the permission level.

13. In the same field of endeavor, Schiavone teaches providing the user an identifier associated with the priority level of the message (see e.g. page 3, ¶0020, lines 7-12).

14. The same motivation utilized in the combination of claim 1, equally applies as well to claim 2.

15. Regarding Claim 3, Abkemeier and Schiavone disclose the invention substantially as claimed. Abkemeier further discloses receiving user information voluntarily submitted by the user, wherein the obtaining of the permission for providing the information to the information user device is realized based on the user information (see e.g. page 5, ¶0048, lines 12-17).

16. Regarding Claim 4, Abkemeier discloses issuing to an information provider device permission information corresponding to permission for the information provider device to provide information (see e.g. Fig. 5, step 67); and permitting to receive the information transmitted based on the permission information transmitted with the information from the information provider device (see e.g. Page 7, ¶0071, lines 6-9). However, Abkemeier does not explicitly teach a permission level related to usability of the information to a user.

17. In the same field of endeavor, Schiavone teaches priority levels associated with email messages based on various factors (see e.g. page 3, ¶0021).

18. It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Schiavone's teachings as

discussed above with the teachings of Abkemeier, for the purpose of lessening or avoiding the impact of virus, spam and denial of service attacks (see Schiavone, ¶0006, page 1, lines 9-11). Abkemeier provides motivation to do so, by providing a system and method for filtering unauthorized messages received by a message recipient while providing an opportunity for senders of unauthorized messages to request authorization (see Abkemeier, page 2, ¶0019, lines 1-4).

19. Regarding Claim 5, Abkemeier and Schiavone disclose the invention substantially as claimed. Abkemeier discloses, selectively using the information permitted to be received in accordance with the permission information (see e.g. Fig. 4, steps 45 & 49). However, Abkemeier does not explicitly teach the permission level.

20. In the same field of endeavor, Schiavone teaches priority levels associated with email messages based on various factors (see e.g. page 3, ¶0021).

21. The same motivation utilized in the combination of claim 4, equally applies as well to claim 5.

22. Regarding Claim 6, Abkemeier and Schiavone disclose the invention substantially as claimed. Abkemeier further discloses, refusing to receive the information transmitted, if only the information is transmitted by the information provider device (see e.g. Fig. 4, steps 49).

23. Regarding Claim 7, Abkemeier and Schiavone disclose the invention substantially as claimed. Abkemeier discloses, refusing to receive the information transmitted. (see e.g. Fig. 4, steps 45 & 46). However, Abkemeier does not explicitly teach the permission level of the permission information transmitted with the information by the information provider device is the lowest.

24. In the same field of endeavor, Schiavone teaches prioritization of the information such as setting the priority level at a lower priority when certain parameters are not met (see e.g. page 3, ¶0022).

25. The same motivation utilized in the combination of claim 4, equally applies as well to claim 7.

26. Regarding Claim 8, Abkemeier and Schiavone disclose the invention substantially as claimed. Abkemeier discloses, updating permission in accordance with how much the information permitted to be received is being used by the information user and reissuing to the information provider device new permission information corresponding to the permission (see e.g. Fig. 4, step 57 & 58). However, Abkemeier does not explicitly teach permission level.

27. In the same field of endeavor, Schiavone teaches priority levels associated with email messages based on various factors a permission level related to usability of the information to a user (see e.g. page 3, ¶0020) .

28. The same motivation utilized in the combination of claim 4, equally applies as well to claim 8.

29. Regarding Claim 9, Abkemeier discloses an information provider/user system comprising an information provider device (see e.g. Fig. 1, 10 sender) and an information user device (see e.g. Fig. 1, 18-22 receiver), the information device including a permission application unit that applies to an information user device for permission to provide information to the information user device (see e.g. Fig. 3, 33); a permission information receiver that receives permission information corresponding to the permission (see e.g. Fig. 3, 35), the permission information being issued by the information user device (see e.g. Fig. 5, step 67); and a transmitter that transmits the information and the permission information received to the information user device (see e.g. page7, ¶0071, lines 6-9); the information user device (see e.g. Fig. 1, 18-22 receiver) including a permission information issuing unit that issues the permission information to the information provider device (see e.g. Fig. 3, 33); and a reception permission unit (see Fig. 3, 35) that permits the information user device (see e.g. Fig. 3, 24) to receive the information based on the permission information transmitted with the information from the information provider device (see e.g. page 7, ¶0071, lines 6-9).

However, Abkemeier does not explicitly teach a permission level related to usability of the information to a user.

30. In the same field of endeavor, Schiavone teaches priority levels associated with email messages based on various factors (see e.g. page 3, ¶0021).

31. It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Schiavone's teachings as discussed above with the teachings of Abkemeier, for the purpose of lessening or avoiding the impact of virus, spam and denial of service attacks (see Schiavone, ¶0006, page 1, lines 9-11). Abkemeier provides motivation to do so, by providing a system and method for filtering unauthorized messages received by a message recipient while providing an opportunity for senders of unauthorized messages to request authorization (see Abkemeier, page 2, ¶0019, lines 1-4).

32. Claim 10, lists all the same elements of claim 2, but in system method form rather than computer program form. Therefore, the supporting rationale of the rejection to claim 2 applies equally as well to claim 10.

33. Claim 11, lists all the same elements of claim 3, but in system method form rather than computer program form. Therefore, the supporting rationale of the rejection to claim 3 applies equally as well to claim 11.

34. Claim 12, lists all the same elements of claim 5, but in system method form rather than computer program form. Therefore, the supporting rationale of the rejection to claim 5 applies equally as well to claim 12.

35. Claim 13, lists all the same elements of claim 6, but in system method form rather than computer program form. Therefore, the supporting rationale of the rejection to claim 6 applies equally as well to claim 13.

36. Claim 14, lists all the same elements of claim 7, but in system method form rather than computer program form. Therefore, the supporting rationale of the rejection to claim 7 applies equally as well to claim 14.

37. Claim 15, lists all the same elements of claim 8, but in system method form rather than computer program form. Therefore, the supporting rationale of the rejection to claim 8 applies equally as well to claim 15.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to form PTO-892 (Notice of Reference Cited) for a list of relevant prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saeed S. Mirzadegan whose telephone number is 571-270-3044. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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